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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/632,661 | 08/01/2003 | Steven M. Casey | 20366-092000 | 3558 |

20350 7590 05/17/2007
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EXAMINER

TIMBLIN, ROBERT M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2167

| MAIL DATE | DELIVERY MODE |
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05/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,661

Applicant(s)

CASEY ET AL.

Examiner

Robert M. Timblin

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action corresponds to application 10/632,661 filed 8/01/2003.

Claims 1-4, 6-7, 9-20 have been examined and are pending under prosecution.

Response to Amendment

Claim 2 has been amended while claim 21 has been newly added. Accordingly, claims 1-4, 6-7, and 9-21 are pending prosecution.

Claim Rejections - 35 USC § 112

The amendment to claim 2 overcomes the previous 35 USC 112 rejection and therefore the rejection is withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1- 9 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim, and thus being directed towards being nonfunctional descriptive material. Software or program can be stored on a medium and/or executed by a

computer. In other words the software must be computer-readable. The use of a computer is not evident in the claims.

In particular, the abstraction or distinction engine being closest to resembling computer hardware is construed to being software *per se*. Suggested or implied use of these elements with computer hardware is unclear to the Examiner or lacking support. For example, in paragraph [0038] of the present invention, the Abstraction/distinction engine can be updated by adding additional software. This teaching leaves the Examiner with the conclusion that the abstraction/distinction engine can be software per se. Software *per se* is non statutory as it is functional descriptive material not causing functional change in a computer. See at least MPEP section 2016.01:

Computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to

realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.

Furthermore, and in response to Applicant's argument on page 7 of the response, simply claiming a "system" is not sufficient to indicate hardware. Quite possibly, a system as claimed can be construed as being a collection of software elements to perform the recited operations. The Examiner could not determine from the specification that the system in claim 1 is intended to be a hardware system.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Elwahab et al. ('Elwahab' hereinafter) (U.S. Patent Application 2001/0034754 A1).

With respect to claim 1, Elwahab teaches A system for abstraction and distinction of content objects, wherein the system comprises:

an abstraction engine (24, 12; figure 1) communicably coupled to a first plurality of content object entities within a customer's premises (14, figure 1), the abstraction engine (24, 12; figure 1) operable to receive a content object from one of the first plurality of content object entities (as the user can use a laptop or hand-held device [0009]), and to form the content object into an abstract form ([0031] and drawing reference 24);

a distinction engine (26, 50; figure 1) communicably coupled to a second plurality of content object entities within the customer's premises (14, figure 1), the distinction engine (26, 50; figure 1) operable to conform the abstracted content object with a standard compatible ([0031, and 50]) with a selected one of the second plurality of content objects as the appliances connected to the Customer Premises Gateway 12. See also paragraph [0023];

wherein the first plurality of content object entities includes at least two content object entities selected from a group consisting of: an appliance control system, a telephone information system, a storage medium including video objects, a storage medium including audio objects, an audio stream source, a video stream source, a human interface, the Internet, and an interactive content entity as a laptop or hand-held computing device will qualify as including at least two of these elements. See also figure 1, abstract and at least paragraphs [0008]-[0009]; and

wherein the second plurality of content object entities includes at least two content object entities selected from a group consisting of: an appliance control system, a telephone information system, a storage medium including video objects, a storage medium including audio objects, a human interface, the Internet, and an interactive content entity as a Customer Premises Gateway 12 and abstract.

With respect to claim 2, Elwahab teaches wherein two or more of the first plurality of content object entities are maintained on separate partitions of a common database 20.

With respect to claim 3, Elwahab teaches wherein the common database is partitioned using a content based schema (120, 58 and figure 1).

With respect to claim 4, Elwahab teaches wherein the common database is partitioned using a user based schema (120, 58 and figure 1).

With respect to claim 6, Elwahab teaches wherein the abstraction engine (24, 12; figure 1) is operable to receive a first content object (commands, [0038], [0065], [0068] and management message [0069] from one of the first content object entities and to derive a second content object based on the first content object, wherein the abstraction engine is further operable to receive a third content object from one of the first content object entities and to derive a fourth content object based on the third content object, and wherein the abstraction engine is further operable to combine the second content object and the fourth content object to create a fifth content object as the sending of commands to the devices (method disclosed at least in paragraphs [0062]-[0065]).

With respect to claim 7, Elwahab teaches wherein the distinction engine (26, 50; figure 1) is operable to format the fifth content object such that the fifth content object is compatible with a selected one of the second plurality of content object entities (appliances, figure 1).

With respect to claim 9, Elwahab teaches an access point (as a PC within the premises; [0062]), wherein the access point indicates a number of content objects associated with the first plurality of content object entities (control and status commands [0038]-[0056], and one or more of the second plurality of content object entities to which respective content objects of the number of content object entities can be directed (list 120; and [0063].

With respect to claim 10, Elwahab teaches a method for utilizing content objects by a content access point within a customer's premises, wherein the method comprises:

accessing a first content object from a first content object entity within a customer's premises (abstract) as loading device specification commands ([0037]-[0054];

abstracting the first content object to create a second content object as presenting the information in Markup-Language-type format ([0059] and 16, 18, and 24; figure 1);

distinguishing the second content object to create a third content object, wherein the third content object is compatible with a second content object entity within a customer's premises as distinguishing the information [0023]; and

providing the third content object to the second content object entity [0032] and passing data to the smart device (figure 1 applications and smart devices of figure 2).

With respect to claim 17, Elwahab teaches querying each of the first plurality of content object entities to identify a first plurality of content objects as discovery mode [0037];

and providing an access point (as a PC within the premises; [0062]), wherein the access point indicates the first plurality of content objects (commands, [0038]), and one or more of the second plurality of content object entities 120 to which each of the first plurality of content objects can be directed.

With respect to claim 18, Elwahab teaches a method for accessing content objects within a customer premises, the method comprising:

identifying content object entities within the customer premises as a PC or handheld device on the premises ([0009] and [0062]);

grouping the identified content object entities into a first plurality of content object entities and a second plurality of content object entities, wherein the first plurality of content object entities are sources of content objects, and wherein the second plurality of content object entities are destinations of content objects as Elwahab suggests this by the PC or handheld device on premises ([0009] and [0062]) as being a source for controlling and monitoring their smart devices (destination). These devices are grouped accordingly in list 120.

providing an guide 28, wherein the guide indicates the first plurality of content objects (commands [0038] and management message [0069], and one or more of the second plurality of content object entities to which each of the first plurality of content objects can be directed as smart devices (figure 1).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14, 16 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elwahab as applied to claims 1-10, and 17-19 above in view of Jeffrey (U.S. Patent 6,576,981).

With respect to claim 11, Elwahab teaches the limitations substantially the same as claims 1-10, and 17-19 presented above.

Elwahab fails to explicitly suggest or teach accessing a fourth content object from a third content object entity; abstracting the fourth content object to create a fifth content object; and combining the fifth content object with the second content object, wherein the combination of the second and fifth content objects are distinguished to create the third content object.

Jeffrey, however, suggests these limitations by using a composite converter (col. 7 lines 14-35) for creating a composite video signal (col. 9 lines 53-55).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because combining the teachings of Jeffrey with Those of Elwahab would have provided the advantage of efficiently integrating broadcast and telecommunications signals from a variety of sources. A further advantage would be permitting interactive signal selection (col. 2 lines 16-30).

With respect to claim 12, Elwahab fails to teach these limitations.

Jeffrey, however, teaches wherein the first content object is a video object 106, and wherein the fourth content object is an audio object 104.

With respect to claim 13, Elwahab fails to teach these limitations.

Jeffrey, however, teaches wherein abstracting the first content object includes separating an audio portion from a video portion of the video object as signal separator 102.

With respect to claim 14, Elwahab teaches wherein the first content object is a video object, and wherein the fourth content object is an Internet object (Markup-language-Type content; [0015]). Elwahab fails to teach a video object whereas Jeffrey teaches a video object 106.

With respect to claim 16 and similar claim 19, the limitations of this claim are rejected substantially the same as those of claims 11-13 for being similar. Furthermore, Elwahab fails to teach removing a visual portion of the video object, and wherein the second content object includes an audio portion of the video object.

Jeffrey, however teaches this limitation as the function of signal separator to separate and audio/video signal.

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because combining the teachings of Jeffrey with Those of Elwahab would have provided the advantage of efficiently integrating broadcast and telecommunications signals from a variety of sources. A further advantage would be permitting interactive signal selection (col. 2 lines 16-30).

With respect to claim 20, Elwahab teaches wherein the method further comprises: accessing a first content object from one of the first plurality of content object entities; eliminating a portion of the content included with the first content object to create a second content object; and providing the second content object to one of the second plurality of content object entities as deleting properties [0074].

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Elwahab and Jeffrey as applied to claims 11-13, 16 and 20 above and further in view of Baer et al ('Baer' hereinafter) (U.S. Patent 6,611,840).

With respect to claim 15, the combination of Elwahab and Jeffrey fail to teach these limitations.

Baer, however teaches wherein the method further comprises: identifying a content object associated with one of the first plurality of content object entities that has expired (as an object entity expiration date; col. 13, lines 49-52); and removing the identified content object as removing content (abstract) for deleting and purging information.

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine the teachings of the cited references because the teaching of Baer would have provided the combination of Elwahab and Jeffrey's invention a way to delete information not in use after expiration.

Response to Arguments

Applicant's arguments filed 2/27/2007 have been fully considered but they are not persuasive.

The Applicant argues on page 10 of the response that Elwahab does not disclose expressly or inherently, 1) abstraction or distinction of content objects and that Elwahab also fails to disclose 2) grouping of sources of content objects as recited in the pending claims. The Examiner respectfully disagrees given the following:

With respect to argument 1), Elwahab teaches the claimed abstraction or distinction of content objects. For instance, Elwahab teaches an abstraction layer 24 that serves as a layer between internetworking protocols and transport protocols (0031). Further, the abstraction layer publishes a standard interface to transport protocols of the software drivers (also in 0031). What can be concluded from this passage is that Elwahab discloses an abstraction layer 24 to produce a standard for the device drivers. In other words, the protocols (in this case that could be “objects”) are abstracted into a standard that can be read by a respective device.

Elwahab also describes a distinction engine as claimed. Specifically, Elwahab teaches distinguishing conducted by the functional blocks provided in figure 1. As software drivers 26 are functional blocks (i.e. providing function) they can be seen to distinguish information from abstraction layer 24, and thus sufficiently teaching a distinction engine. Also, in other words, the software drivers distinguish the information (by distinction) from abstraction layer 24.

In conclusion, Elwahab teaches the claimed abstraction or distinction of objects as claimed by Applicant.

The Applicant further argues on page 11 of the response that 2) Elwahab fails to teach grouping sources of content objects as recited in claim 18. The Examiner respectfully disagrees given the following:

As recited in paragraph [0009] of Elwahab:

a device, system and method for centralized Markup-Language-type enabled (including XML enabled) web browser access and control of smart devices, appliances and systems such as HVAC, lighting and security systems on the customer premise in which an initial access Markup-Language-type page is accessible from local or remote locations from which the user can establish network access using essentially any computer, laptop or hand-held computing device. In other words, the user is not limited to local or remote access to the smart devices via a particular computer on which a specific appliance automation program is installed.

From at least this passage, one can see that a device with the ability to access and control smart devices. As the device can be a laptop or hand-held computing device, this device in effect acts as a source of information (i.e. controlling information) to the second content object entities (smart devices in figure 1). Furthermore, the laptop or handheld computing device sufficiently teaches a plurality of content object entities (as construed from claim 1). That is a laptop teaches at least an appliance control system, a human interface, the Internet (suggested by drawing reference 28 of figure 1 and abstract) and an interactive content entity. With the device comprising at least these elements of the claimed invention, they are therefore grouped accordingly in one device.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Timblin whose telephone number is 571-272-5627. The examiner can normally be reached on M-F 8:00-4:30.

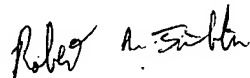
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR


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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert M. Timblin



Patent Examiner AU 2167
5/8/2007



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